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09/734,693	12/13/2000	John Archer	CITI0140	6527
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KILPATRICK STOCKTON LLP			COLBERT, ELLA	
607 14TH STREET, N.W.			ART UNIT	
WASHINGTON, DC 20005			PAPER NUMBER	
			3624	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/734,693

**Applicant(s)**

ARCHER ET AL

**Examiner**

Ella Colbert

**Art Unit**

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-30 are pending. Claims 1 and 16 have been amended in this communication filed 1/11/06 entered as Response After Non-Final Action and Request for Extension of Time.
2. Claims 1 and 16 have been amended to overcome the 35 USC 112, second paragraph rejection and the rejection is hereby withdrawn.

### ***Claim Objections***

3. Claims 2 and 17 are objected to because of the following informalities: Claims 2 and 17 contain the acronym "OFAC". This acronym should be written as follows: Office of Foreign Assets Control (OFAC). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 10-16 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,995,979) Cochran.

As per claim1, Cochran teaches, A method of searching financial transactions against a server-resident matchable text pattern file of sanctioned entities using a network, the network including a plurality of servers accessible by a plurality of user

terminals, comprising: inputting at one of the plurality of user terminals a search request text pattern for searching the server-resident matchable text pattern file of sanctioned entities, the search request text pattern including a text string, the text string further including one or more regular expression operators, including letters, digits or punctuation marks to further define the search request text pattern and to further identify a server being invoked among the plurality of servers (col. 7, line 9- col. 8, line 44 and fig. 2); storing the search request text pattern as an entry in a search request instruction file, the search request instruction file being accessible by a server processor (col. 6, lines 6-10); transmitting the search request instruction file to the server processor invoked via the network (col. 6, lines 40-42, fig. 2); the server processor checking the search request text pattern, the checking including determining a match of the search request text pattern against the matchable text pattern file of sanctioned entities in the server (col. 6, lines 44-47); and upon execution of the search, transmitting search results to the one of the plurality of user terminals via the network (col. 7, line 55- col. 8, lines 65 and fig. 2 (42)).

As per claim 10, Cochran teaches, The method according to claim 1, further comprising: generating a user authorization code at the time the terminal user inputs a text pattern selection for checking against a sanctioned entity database (col. 6, lines 45-50); and storing the authorization code with the text pattern selection in the search request instruction file, wherein the authorization code must be received in order to access the server (col. 6, lines 53 - col. 7, lines 4).

As per claim 11, this dependent claim is rejected for the similar rationale as above for claim 10.

As per claim 12, Cochran teaches, The method according to claim 1, wherein matchable text pattern files are replicated between each server via the network (col. 5, line 49-col. 6, line 5 and fig. 1).

As per claim 13, Cochran teaches, The method according to claim 12, wherein matchable text pattern files are mutually updating via the network (col. 3, lines 45-52 and col. 8, lines 54-65).

As per claim 14, Cochran teaches the invention substantially as claimed with the exception of the server failure automatically routes search request instruction files to an alternate server. However, since Cochran teaches a communication link between users and remote servers in the communication network, the feature that the server failure automatically routes the search request instruction files to an alternate server is inherent in the system in order to retrieve a search result.

As per claim 15, Cochran teaches, The method according to claim 1, wherein the search request instruction file is generated by a computer program (col. 5, lines 56-64).

As per claim 16, this independent claim is rejected for the similar rationale as given above for corresponding claim 1. Corresponding claim 1 claims a method with steps that correspond to the system steps of claim 16.

As per claim 25, this dependent claim is rejected for the similar rationale as given above for corresponding claims 10 and 11.

As per claim 26, this dependent claim is rejected for the similar rationale as given above for corresponding claims 10, 11, and 25.

As per claim 27, this dependent claim is rejected for the similar rationale as given above for corresponding claim 12.

As per claim 28, this dependent claim is rejected for the similar rationale as given above for corresponding claim 13.

As per claim 29, this dependent claim is rejected for the similar rationale as given above for corresponding claim 14.

As per claim 30, this dependent claim is rejected for the similar rationale as given for corresponding claim 15.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,995,979) Cochran in view of "Compliance Solutions".

As for claims 2 and 17, Cochran failed to teach, The method according to claim 1, wherein the server-resident matchable text pattern file includes the OFAC sanction list. "Compliance Solutions" teaches, The method according to claim 1, wherein the server-resident matchable text pattern file includes the OFAC sanction list (page 2). "Compliance Solutions" did not expressly teach, "a server". However,

Cochran teaches, a server (col. 6, lines 1-5 and fig. 1 (710) for matching a text pattern file list. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the server-resident matchable text pattern file include the OFAC sanction list and to combine Cochran's server-resident matchable text pattern file that includes a list with "Compliance Solutions" OFAC sanction list because this would allow Cochran to know that the institution sending and receiving payments to a person or entity is on the master list issued by OFAC in order to avoid paying a fine.

As per claims 3 and 18, Cochran teaches, The method according to claim 2, wherein servers are located in different countries (col. 6, lines 11-23 and fig 1 (750) – Internet).

As per claims 4 and 19, Cochran teaches, The method according to claim 3, wherein the server includes a plurality of matchable text pattern files including user defined sanction lists (col. 1, lines 30-37 and col. 8, lines 45-53).

As per claims 5 and 20, Cochran teaches, The method according to claim 4, wherein the search request instruction file further defines the matchable text pattern files to be searched (col. 6, lines 6-10).

8. Claims 6-9 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,995,979) Cochran and "Compliance Solutions" in view of (US 5,842,219) High, Jr. et al, hereafter High, Jr.

As per claim 6, Cochran and "Computer Solutions" failed to teach, The method according to claim 1, further comprising: defining sanctioned entities as matchable text

patterns; storing matchable text patterns as individual phrases; arranging individual phrases as a letter tree array; generating a search node for each character in the search request text pattern to be checked against matchable text patterns; comparing search nodes against characters and positions in the letter tree array; and determining whether a match occurs. High, Jr. teaches, defining sanctioned entities as matchable text patterns (col. 2, lines 35-51); storing matchable text patterns as individual phrases; arranging individual phrases as a letter tree array (col. 3, lines 37-47); generating a search node for each character in the search request text pattern to be checked against matchable text patterns (col. 5, line 65-col. 6, line 9 and fig. 4A); comparing search nodes against characters and positions in the letter tree array; and determining whether a match occurs (col. 6, lines 10-35 and fig. 4B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to define sanctioned entities as matchable text patterns; store matchable text patterns as individual phrases; arrange individual phrases as a letter tree array; generate a search node for each character in the search request text pattern to be checked against matchable text patterns; compare search nodes against characters and positions in the letter tree array; and determine whether a match occurs and to modify in Cochran in view of Cochran's teachings of multiple lists of search terms and matching text patterns and because such a modification would allow Cochran to have an enhanced search capability within a object-oriented distributed computing network.

As per claim 7, Cochran and "Computer Solutions" failed to teach, The method according to claim 6, wherein the search request instruction file includes a spell correct



flag to include spelling variations of the search request text pattern to be checked against the matchable text pattern file. High, Jr. teaches, the search request instruction file includes a spell correct flag to include spelling variations of the search request text pattern to be checked against the matchable text pattern file (col. 5, lines 14-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the search request instruction file include a spell correct flag to include spelling variations of the search request text pattern to be checked against the matchable text pattern file and to modify in Cochran because such a modification would allow Cochran to compare the temporary index in order to remove the coexisting property names from the property name list and to build a new temporary list of correct spelling variations of the text pattern and to append it to the existing index.

As per claim 8, Cochran and "Computer Solutions" failed to teach, The method according to claim 6, wherein the search request instruction file includes a missing letters flag to include missing letters in the text pattern to be checked against the matchable text pattern file. High, Jr. teaches, the search request instruction file includes a missing letters flag to include missing letters in the text pattern to be checked against the matchable text pattern file (col. 6, lines 16-35 and fig. 4A). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the search request instruction file includes a missing letters flag to include missing letters in the text pattern to be checked against the matchable text pattern file and to modify in Cochran because such a modification would allow Cochran to have

comparison operations, logical operations, and set operations to be performed to check the text pattern against the matchable text pattern.

As per claim 9, Cochran and "Computer Solutions" failed to teach, The method according to claim 6, wherein the search request instruction file includes a transposed letters flag to include transposed letters in the text pattern to be checked against the matchable text pattern file. High, Jr. teaches, the search request instruction file includes a transposed letters flag to include transposed letters in the text pattern to be checked against the matchable text pattern file (col. 5, lines 14-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the search request instruction file includes a transposed letters flag to include transposed letters in the text pattern to be checked against the matchable text pattern file and to modify in Cochran because such a modification would allow Cochran to have the capability to determine when letters are transposed in the text pattern of the searchable matchable text pattern.

As per claim 21, this dependent claim is rejected for the similar rationale as above for corresponding claim 6.

As per claim 22, this dependent claim is rejected for the similar rationale as given above for corresponding claim 7.

As per claim 23, this dependent claim is rejected for the similar rationale as given above for corresponding claim 8.

As per claim 24, this dependent claim is rejected for the similar rationale as given above for corresponding claim 9.

***Response to Arguments***

9. Applicants' arguments filed 03/21/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Cochran does not disclose "inputting at one of the plurality of user terminals a search request text pattern ... including a text string ... to further define the search request text pattern and to further identify the server being invoked among the plurality of servers, (emphasis added)" as recited in claims 1 and 16 and Cochran teaches away from determining a match by presenting the user only search terms that will return a hit has been considered but is not persuasive.

Response: It is interpreted that in Cochran's system a user can enter a search request -"in response to a request by a user at a remote computer terminal 720, the server 710 transmits information to the user's computer" in col. 7, lines 10-14 is considered to be a user entering a query which would be a text query. As for Cochran teaching away from determining a match by presenting to the user only search terms that will return a hit, disclosed examples and preferred embodiments **do not constitute a teaching away** from a broader disclosure or non-preferred embodiments. *In re Susi*, 169 USPQ 423 (CCPA 1971).

It is noted that in claims 1 and 16 recite "the text string further including one or more regular expression operators, including letters, digits, or punctuation marks ...". The Specification recites "Matchable Text Patterns 5B may include one or more

regular expression operators, such as letters, digits, spaces, synonyms or abbreviations ...". The claim limitation in claims 1 and 16 is not agreement with the Specification.

Applicants' invention is mainly a text retrieval and search system which is well known in the art of text searching on the internet. The method steps are steps that are used in performing a search and retrieving the information.

Conclusion: In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in the Cochran, "Compliance Solutions", and High, Jr. references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

**>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION**

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Applicants' are respectfully requested to point out to the Examiner which claim limitation in Claims 1 and 16 is considered to be the inventive concept because the inventive concept can not be determined from the claim limitations as written.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Inquiries***


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ella Colbert  
Primary Examiner  
April 1, 2006



ELLA COLBERT  
PRIMARY EXAMINER